

REMARKS

In the Final Office Action¹, the Examiner rejected claims 25 and 26 under 35 U.S.C. § 101; rejected claims 1-4, 8-9, 12-15, 19-22, and 25-26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,697,865 to Howard et al. ("*Howard*"); and rejected claims 5-7, 10-11, 16-18, and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over *Howard* in view of U.S. Patent Application Publication No. 2002/0138331 to Hosea et al. ("*Hosea*").

By the present amendment Applicants have amended claims 1, 14, and 25-26 and added new claims 27-34. Upon entry of the claim amendments, claims 1-34 will remain pending in this application.

I. Information Disclosure Statements filed March 20, 2008 and April 8, 2008

On page 2 of the Final Office Action, the Examiner states: "Applicant has submitted 46 patents [*sic*] documents for review. Due to the large number of documents, the Examiner has made a *cursory review* of this collection and requests that the Applicant cite passages relevant to the examination of the filed claims" (emphasis in original). Applicants respectfully disagree with the Examiner. The M.P.E.P does not require Applicants to "cite passages relevant to the examination of the filed claims" and Applicant has met all requirements for submitting these documents, particularly since all documents are U.S. patents or English language documents. See M.P.E.P § 609.04(a). Further, 46 documents is not a "large number of documents," as examination of an

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

application usually entails the review of even a larger number of prior art documents during examination.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the request by the Examiner to cite passages relevant to the examination of the filed claims.

II. Rejection of Claims 25 and 26 under 35 U.S.C. §101

On page 2 of the Office Action, the Examiner rejected claims 25 and 26 under 35 U.S.C. § 101 as being allegedly directed to “machine-readable signal.” Applicants respectfully traverse the rejection of claims 25 and 26 for at least the following reasons.

Claims 25 and 26 specifically recite, among other things, a “**machine-readable storage medium including machine-readable instruction**” and “a processor.” Therefore, claims 25 and 26 are directed to a “machine-readable storage medium,” and are **not** directed solely to machine-readable signal, as alleged by the Examiner. Accordingly, claims 25 and 26 recite statutory subject matter.

The Examiner is reminded of the guidelines provided in the M.P.E.P. Specifically, the M.P.E.P. states:

When a computer program is claimed in a process where the computer is executing the computer program's instructions, USPTO personnel should treat the claim as a process claim. When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a **product claim**. See M.P.E.P. § 2106.01 (emphasis added).

In view of the foregoing, Applicants submit that claims 25 and 26 squarely fall within the categories of patentable subject matter. Accordingly, Applicants respectfully

request reconsideration and withdrawal of the rejection of claims 25 and 26 under 35 U.S.C. §101.

III. Rejection of Claims 1-4, 8-9, 12-15, 19-22, and 25-26 under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejections of claims 1-4, 8-9, 12-15, 19-22, and 25-26 under 35 U.S.C. § 102(e), as being anticipated by *Howard*. In order to properly establish that *Howard* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Amended independent claim 1 recites a method including, among other steps "identifying one or more entities related to the user, said one or more entities having corresponding entity profiles including context information comprising a **plurality of types of categorized data**" and "importing at least the portion of the context information into the user profile, wherein the imported portion comprises data **selected from the plurality of types of categorized data**" (emphasis added). *Howard* does not disclose at least these elements of claim 1.

In *Howard*, user profiles are given limited permissions based on the permissions assigned to the user's company. (See *Howard*, column 4, lines 36-47.) *Howard*, however, does not teach or suggest "identifying one or more entities related to the user, said one or more entities having corresponding entity profiles including context information comprising a **plurality of types of categorized data**," as recited in claim 1.

Moreover, *Howard* does not teach or suggest the claimed user profile wherein an imported portion of the context information in the user profile comprises data **“selected from the plurality of types of categorized data,”** as further recited in claim 1. At most, *Howard* only teaches assigning permissions to user profiles based on profiles of the user’s companies.

The Examiner alleges that the “permissions” of *Howard* constitutes Applicants’ claimed “context information.” (Final Office Action, page 8.) Even assuming, arguendo, that the “permissions” of *Howard* could constitute the claimed “context information,” *Howard* does not teach or suggest “context information comprising plurality of types of categorized data” and importing at least the portion of the context information wherein “the imported portion comprises data selected from the plurality of types of categorized data,” as recited in independent claim 1.

Therefore, for at least these reasons *Howard* cannot anticipate claim 1 and the rejection of claim 1 should be withdrawn.

Independent claims 14, 25, and 26 while of different scope, recite elements similar to those of claim 1 and are thus allowable over *Howard* for at least similar reasons to those discussed above for to claim 1. Claims 2-4, 8-9, 12-13, 15, and 19-22 are also allowable at least due to their dependence from independent claims 1 or 14.

Accordingly, for at least the reasons noted above, the rejections under 35 U.S.C. § 102(e) are improper and should be withdrawn.

IV. Rejection of Claims 5-7, 10-11, 16-18, and 23-24 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 5-7, 10-11, 16-18, and 23-24 under 35 U.S.C. § 103(a) as being unpatentable over *Howard* in view of *Hosea*

because a *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P.* § 2142, 8th Ed., Rev. 6 (Sept. 2007). “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P.* § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P.* § 2143.01(III), *internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P.* § 2141.02(I), *internal citations omitted* (emphasis in original).

Claims 5-7, 10-11, 16-18, and 23-24 depend from claims 1 or 14, and thus require all elements of claims 1 or 14. *Hosea* fails to remedy the above-noted deficiencies of *Howard* with respect to independent claims 1 and 14. For example, *Hosea* fails to disclose or suggest among other things, “identifying one or more entities related to the user, said one or more entities having corresponding entity profiles including context information comprising plurality of types of categorized data” and “importing at least the portion of the context information into the user profile, wherein the

imported portion comprises data selected from the plurality of types of categorized data” as required by independent claims 1 and 14. Consequently, any proper combination of *Howard* and *Hosea* does not present a *prima facie* case of obviousness with respect to claims 1 and 14. Claims 5-7, 10-11, 16-18, and 23-24 depend from claims 1 or 14, and are therefore also allowable.

Accordingly, for at least the above-noted reasons, reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal off each of the rejections and the timely allowance of all pending claims. As demonstrated above, Applicants’ claims are neither anticipated nor rendered obvious by the prior art references cited against this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: _____

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